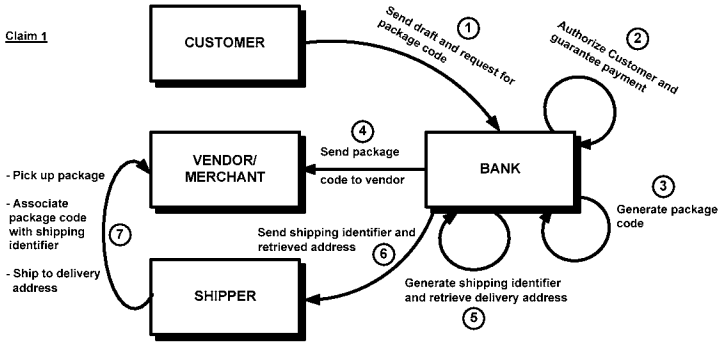
REMARKS

At the outset, the undersigned wishes to thank Examiner Gilligan for his time and courtesy during the telephone interview of June 26, 2007. As the Examiner will recall, the undersigned's stated opinion was that the Office's proposed modification of Shub et al. to aggregate the 1st, 2nd shipper and the 1st and 2nd clearinghouses into a single entity is contrary to the teachings of Shub et al. and would render Shub et al. unsatisfactory for its intended purpose and would impermissibly change the principle of operation of Shub et al. As the Examiner will also recall, during the telephone interview of January 18, 2007, it was also established that the secondary reference to Kadaba was relied upon for its teaching that a shipper, such as UPS (the assignee of Kadaba) may include a plurality of clearinghouses and use a plurality of "shippers" – meaning multiple trucks, planes and trains, for example.

Turning now to the final Office Action mailed October 6, 2006, claims 1-4, 7-10 and 13-16 were rejected under 35 U.S.C. §103(a) over Shub et al. in view of Kadaba. Reconsideration and withdrawal of these rejections are respectfully requested.

Here, again, is a graphical representation of the recited steps of claim 1:



Note, in particular, steps 1, 5 and 6, which correspond to the recited steps of claim 1:

the method comprising the steps of:

the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;

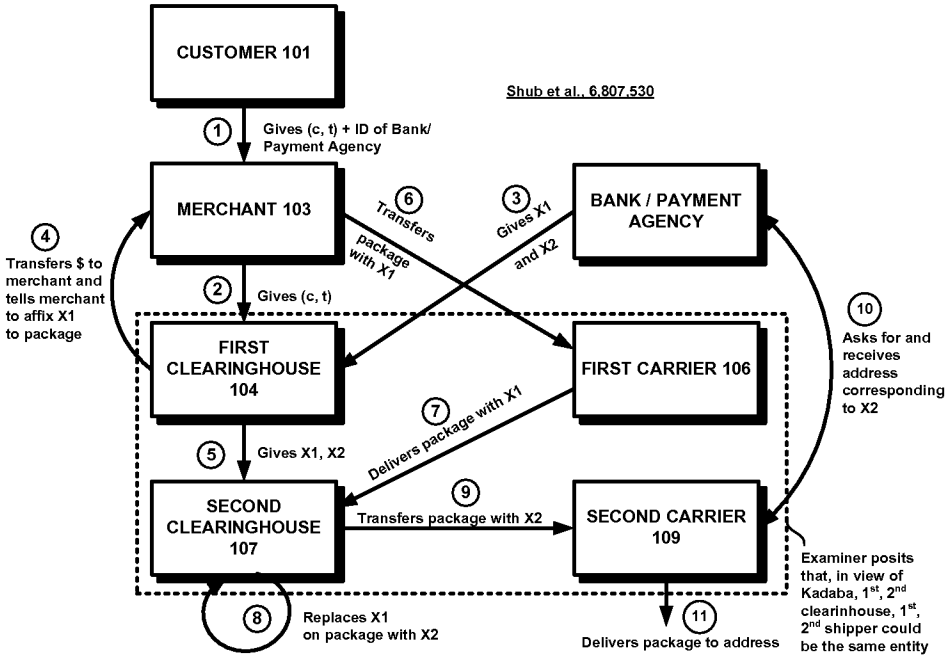
…

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and

the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper

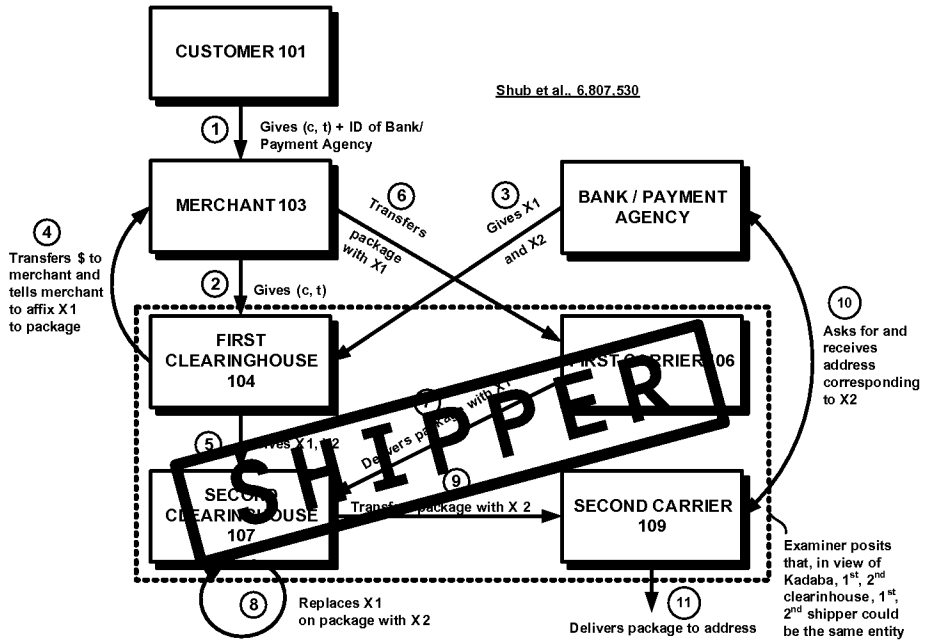
As will be demonstrated below, these claimed steps are not taught or suggested by the applied combination, nor are such steps taught or suggested indirectly through a series of intermediate steps that, in the aggregate, would be equivalent to the above steps.

Again, Shub et al.'s method looks like this:



The Office's position that the 1st, 2nd shipper and the 1st and 2nd clearinghouses could be aggregated into a single entity for the purposes of a §103(a) rejection is, respectfully, contrary to both established Court precedents and the Patent Office's own guidelines for the examination of

patent applications. If, *arguendo*, the 1st, 2nd shipper and the 1st and 2nd clearinghouses were to be aggregated into a single entity, Shub et al.'s method would look like this:



In that case, all that is left is a configuration in which a single shipper picks up the goods directly from a merchant and delivers them to a delivery address. This, clearly, would render Shub et al.: a) arguably unsatisfactory for its intended purpose; and b) certainly impermissibly change its principle of operation. Indeed, one of the stated goals of Shub et al. is to prevent any single party (except the customer) from having complete information about a transaction. Indeed, if the 1st, 2nd clearing houses and 1st and 2nd carriers were to be combined as suggested by the Office, the single shipper would then have complete knowledge of the transaction, including the name and address of the customer, from whom the customer purchased the goods in question, the identity of the customer's bank and the price (denoted by s(M) in Shub et al.) paid by the

customer for the goods. This, however, is explicitly contrary to the methods and apparatus of Shub et al.:

> (57) **ABSTRACT**
>
> A method and apparatus which enables customers to remotely order goods from a merchant and receive the goods without revealing customer identity or address to the merchant, nor revealing what is bought to the bank or payment agency, and more generally to preserve as much anonymity as required such that no party except the customer has complete information about a transaction. The method uses clearing houses or encryption to break links between customer information and the merchant.

Shub et al., however, are not wholly inflexible and teach that some modifications are possible (Col. 4, lines 10-14):

> Clearly, if the customer **101** so desires, she/he can ask the merchant **103** to only use some simplified version of the protocol, in particular avoiding one of the clearing houses **104** and **107** whose role will be described below. The

Likewise, Shub et al. also teach that the first carrier and the merchant may be a single entity (Col. 5, lines 25-29):

> involved in the buy can be recognized, the merchant **103** transfers all packages **105** labeled with first bank order number x**1** to the first carrier **106**: the merchant **103** may well be that carrier without compromising the anonymity of the customer.

The clearing houses could even belong to the same company (Col. 5, lines 45-47):

> a portion of s(TPH): notice that clearing houses **104** and **107** can belong to the same company without reducing the security of the system.

However, nowhere in Shub et al., is any teaching or suggestion to aggregate the 1st and 2nd clearinghouse with the 1st and 2nd carriers, as urged by the Office. Indeed, Shub et al. cannot

arbitrarily be interpreted to teach only a single carrier. Kindly recall that two bank order numbers X1 and X2 are necessary in Shub et al. In fact, Shub et al. explicitly and most emphatically state that "**An essential part of the invention is that a clearinghouse replaces X1 with X2**" (Col. 4, lines 57-58). This step is essential, because it is the bank order number X2 that is used by the **second** carrier to obtain the ultimate delivery address from the payment agency 102 (Step 10 above). The **first** carrier delivers the package from the merchant to the second clearing house 107 (Step 7 above) and the **second** carrier delivers the package (this time, labeled with bank order number X2) from the second clearing house 107 to the address given to it by the payment agency 102.

Such indirection (first and second clearing houses, first and second carriers) are necessary in Shub et al. to prevent any one party (other than the customer) from having complete knowledge of the transaction, a stated goal of this reference. To arbitrarily aggregate the clearing houses and the carriers would both render Shub et al. unsatisfactory for its intended purpose and would impermissibly change the principle of operation of Shub et al.

The Office's attention is drawn to the guidance promulgated by the MPEP in cases such as these as well as to the authorities cited by the Patent Office in support of the promulgated guidance:

> **M.P.E.P. Section 2143.01, Suggestion or Motivation to Modify the References**
> **THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**
> **If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter**

assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

In the present case, it is respectfully submitted that aggregating the clearing houses and carriers into a single carrier would do both of these things. Therefore, it is respectfully submitted that the Office is not free to characterize the Shub et al. reference in a manner that would change its principle of operation (as a single carrier that would replace both the clearing houses and the carriers certainly would) and render it unsatisfactory to its intended purpose (namely, to prevent any one party from having complete knowledge of the customer's transactions and to preserve the identity of the customer from the various players).

Note that Shub et al. do disclose an embodiment that uses encryption rather than clearing houses (Col. 5, beginning at line 64). However, such methods involve the payment agency

issuing a series of numbers for remote buys which the customer must give to an agent of the merchant upon making a purchase (Col. 6, beginning at line 43) and receives an order number in exchange (Col. 6, lines 49-50). A label that does not reveal the delivery address in the clear (it is accessible a secret encoding key in the possession of the carrier) may then be printed at the merchant's locale (Col. 6, lines 59 to Col. 7, line 2). However, such does not teach or suggest the claimed embodiments, either alone or in combination with the secondary reference. For example, none of the steps of claim 1 are taught in this alternative embodiment:

> **the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;**
>
> **...**
>
> **the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and**
>
> **the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper**

Lastly, Shub et al. disclose a last embodiment in the penultimate paragraph before the claims, at Col. 7, lines 10-21:

> There are modifications possible to this invention, obvious to anyone skilled in the art. For example, the merchant **311** could simply print a label with the order number corresponding to the customer order **307** and attach it to the package and give it to the delivery agency **310**. The delivery agency **310** could then contact the payment agency **303** with the order number and obtain a shipping address which can be printed and attached to the package. While the invention has been described in terms of a preferred embodiment and an alternate embodiment, those skilled in the art will recognize that the invention can be practiced with modification within the spirit and scope of the appended claims.

This modification teaches the following steps:

1) The merchant prints a label with an order number that corresponds to the customer order 307 (which presumably corresponds to one of the provided "series of numbers for remote buys");

2) The merchant attaches the label to the package;

3) The merchant gives the labeled package to the delivery agency;

4) The delivery agency contacts the payment agency, gives it the order number on the label and obtains therefrom the shipping address of the package.

However, wholly unsuggested by this last modification proposed by Shub et al. would be the claimed steps:

> **the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;**
>
> **...**
>
> **the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and**
>
> **the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper**

For example, such a modification does not teach or suggest any step of the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper, as claimed in claim 1. Such a modification also does not teach or suggest, whether considered alone or in combination with Kabada, the recitation in claim 7, which is written from the shipper's point of view:

> **the shipper receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank**

Indeed, Shub-Kadaba do not teach or suggest any of the first or second shippers (individually or collectively) receiving a shipping identifier and a delivery address form a bank.

Claim 13, written from the point of view of the merchant, also recites steps that are not taught or suggested by Shub-Kadaba:

the vendor receiving payment on the draft and the package code from the bank only if the customer is authenticated by the bank and bank-imposed constraints are satisfied, the package code being devoid of delivery address information;

In Shub et al.'s alternative embodiments, the customer is provided with a "series of numbers for remote buys" (Col. 6, lines 8-12) and the vendor is provided with the package code (from the bank – not the customer as in Shub et al.'s alternate embodiment) only if the customer is authenticated by the bank and the bank-imposed constraints are satisfied.

Therefore, each independent claim defines methods and specifically-identified steps that are not shown or suggested, either directly or indirectly, by the applied combination of references. In view thereof, it is respectfully submitted that the 354 U.S.C. §103(a) rejection applied to the claims should be reconsidered and withdrawn. The same is, therefore, respectfully requested.

It is respectfully believed that the present response is properly enterable and the present application allowable after final rejection for the following reasons. At the outset, the present response places this case in condition for allowance, as the cited combination of references is not believed to teach or to suggest the recited structure of the independent claims, as developed in detail above. Moreover, none of the claims were amended. Thus, all of the claims (both independent and dependent) have been fully searched by the Examiner. Of course, the Examiner may wish to perform an updated search prior to allowing this application. However, such a search is not necessitated by the nature of the response herewith. The present application is also believed to be allowable without undue additional consideration, as the Examiner has already considered each of the recitations of each independent claim. As the independent claims have been fully

distinguished from the applied combination, and proper authorities cited for the impropriety of so modifying the Shub et al. reference, Applicant believes that the applied rejections have been overcome in a manner that enables the application to be allowed without further search and/or consideration. Indeed, any further consideration that might be required is believed to be *de minimis*, as the present amendment is believed to place this application in condition for allowance without consideration of any new claim amendment, issues and/or subject matter. Therefore, this application is believed to be in allowable form without requiring the applicant to expend additional fees to refile and re-prosecute this application or go to the added expense of filing a pre-appeal brief or prosecuting a full appeal before the Board.

Applicant's attorney, therefore, respectfully submits that all claims are allowable and, therefore, the present application is in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

Respectfully submitted,

Date: June 26, 2007 By: _____

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